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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/452,844	12/03/1999	IVO RAAIJMAKERS	ASMEX.256A	1825

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KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

EXAMINER	
ROCCHEGIANI, RENZO	
ART UNIT	PAPER NUMBER
2825	

DATE MAILED: 01/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/452,844	Applicant(s) RAAIJMAKERS ET AL.	
	Examiner Renzo N. Rocchegiani	Art Unit 2825	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 December 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☐ The period for reply expires _____months from the mailing date of the final rejection.

b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☐ The proposed amendment(s) will not be entered because:

   (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet*.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☐ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: *1,3-30,33-35 and 55-63*.

   Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☐ Other: _____

MATTHEW SMITH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800

Continuation of 5. does NOT place the application in condition for allowance because: applicant's arguments are not persuasive. The main basis of applicant's arguments is the Federal Circuit Court opinion in Ecolochem Inc. v. Southern California Edison Co.. The examiner disagrees with applicant's view of the case. In Ecolochem Inc. the Federal Circuit discussed the need of a motivation in an obviousness rejection but the motivation was necessary to combine the Houghton reference with U.S. Patent No. 4,430,226 to Martinola. The combination was necessary because the Houghton reference did not teach all the elements in the Ecolochem patent. The examiner understands this point and fully agrees with the Federal Circuit, i.e. that there need to be motivation to combine TWO or more references, that motivation must be present for the combination of references to be proper. The present case is different in that the limitation for which applicant is asking motivation is found in the main reference. Unlike the Ecolochem case, the examiner did not combine the main reference with any other reference to teach the limitation of using a high k dielectric. Unlike what applicant proposes, the Federal Circuit never stated that there needs to be motivation behind each limitations that is taught by the main reference. In Ecolochem the Federal Circuit did not question the motivation behind the reaction of hydrazine and dissolved oxygen, instead the Federal Circuit focused on the limitation that Houghton did NOT teach, i.e. the use of a mixed bed to decrease the contamination of the water, a problem not even addressed by Houghton. The Federal Circuit is instead very clear that the motivation is necessary behind the combination of different references. See Ecolochem Inc., 227 F.3d at 1371-72. As for the quote that one with oridnary skill in the art would not have used the Houghton reference in light of the prior art, this quote is correct because there did not seem to be any prior art that did not teach away from Houghton and thus combinable to arrive at the process claimed. The present case is different because the process claimed has been arrived by the main reference except for minor obvious variations which the applicant has not even opposed. Instead applicant argues a limitation in the main reference and asks for motivation behind that limitation. Contrary to applicant's arguments the Ecolochem case affirms the examiner position. Thus, the rejection stands.